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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,162	09/25/2003	Barry J. Gilhuly	1400-1072C4	7030

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EXAMINER
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STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2448

NOTIFICATION DATE	DELIVERY MODE
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12/02/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

portfolioprossecution@rim.com  
uspto-inbox@danamraj.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/671,162	<b>Applicant(s)</b> GILHULY ET AL.	
	<b>Examiner</b> AARON STRANGE	<b>Art Unit</b> 2448	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 71-81,95 and 107-110 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 71-81,95 and 107-110 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Terminal Disclaimer***

1. The terminal disclaimers filed on 7/13/2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent Application Nos. 09/782,412 and 09/782,107 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 71 and 95 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 71, 72, 74, 77, 79, 95 and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023).

Art Unit: 2448

5. With regard to claim 71, Eggleston discloses a wireless system coupled to a messaging host (post office host server) and to a wireless data network (network accessible via BS1)(col. 4, ll. 52-55) that provides an interface for one or more data items (email messages) associated with a user's computer between the messaging host and the wireless data network, the wireless system comprising:

a redirector component (communication server) configured to interface with the messaging host via a wide-area packet network (post office may be coupled to VSM by a WAN)(col. 4, ll. 57-61), wherein the one or more data items are received at the messaging host (emails are received by and stored at the post office)(col. 6, ll. 61-63) and have a first address identifying a mailbox that is viewable at the user's computer (mailbox is user's personal email post office box)(col. 6, ll. 59-61); and

the redirector component for causing the one or more data items to be redirected to a second address (wireless network address) associated with a mobile data communication device (messages are sent to the remote device at the network address of the device)(col. 4, ll. 29-35);

wireless gateway means for interfacing the data items to the wireless data network (VSM forwards the emails to the mobile device via the wireless network)(col. 6, l. 66 to col. 7, l. 6).

However, Eggleston fails to specifically disclose that the data items are packaged in an envelope when they are redirected via the wireless network or that the redirector is configured to remove the outer envelope of a data item repackaged at and received from the mobile data communication device.

Hall discloses a similar system for transporting an electronic mail message across different network types (Abstract). Hall teaches encapsulating an electronic mail created for transmission via a first network in outer envelopes for transmission over a second type of network (col. 2, l. 45 to col. 3, l. 8). Hall further discloses that the outer envelope is removed at either end of the tunnel and the message is processed as usual (col. 3, ll. 3-8). This would have been an advantageous addition to the system disclosed by Eggleston since it would have allowed the e-mail and reply messages to be created in the same format and simply tunneled over the wireless network using an outer envelope. This would have advantageously eliminating the need to convert messages between formats used by different networks.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the messages over the wireless network using an outer envelope to eliminate the need to convert message formats for communication over different network types.

6. With regard to claim 72, Eggleston further discloses that the one or more data items interfaced to the wireless data network are original data items (email messages may be forwarded to the mobile device without modification)(col. 6, l. to col. 7, l. 1).

7. With regard to claim 74, Eggleston further discloses that the one or more data items are compressed data items (messages may be compressed)(col. 11, ll. 63-67).

Art Unit: 2448

8. With regard to claim 77, Eggleston further discloses that the one or more data items interfaces to the wireless data network are copies of the data items (a copy of the message is retained at the server and sent to the wireless network)(col. 12, ll. 32-39 and 59-62).

9. With regard to claim 79, Eggleston further discloses that the one or more data items are compressed data items (messages may be compressed)(col. 11, ll. 63-67).

10. Claim 95 is rejected under the same rationale as claim 71, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

11. With regard to claim 110, Eggleston further discloses that the one or more data items comprise email messages from senders (col. 6, ll. 59-61), and the method further comprises configuring a preferred list of senders whose messages are to be sent to the user's mobile data communication device (messages may be filtered based on the sender)(col. 8, ll. 14-30).

12. Claims 73, 78, 107 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023) further in view of Murota (US 6,289,105).

Art Unit: 2448

13. With regard to claim 73, 78, 107 and 108, while the system disclosed by Eggleston and Hall shows substantial features of the claimed invention (discussed above), it fails to disclose that the one or more data items are encrypted data items.

Murota discloses a similar system for sending e-mail messages between a sender and a receiver, wherein a message is encrypted at the sending end, is then transmitted over the network to the receiving end, and is finally decrypted at the receiving computer (col. 1, ll. 23-48). Murota further discloses that such an encryption scheme is advantageous because it prevents leaks of secret information to outside, non-intended parties (Murota, col. 1, ll. 49-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the data items to prevent unauthorized parties from accessing the contents of the data items.

Regarding claim 107, it is noted that encoding the data items is a necessary part of encrypting them.

14. Claims 75, 80 and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023) further in view of Official Notice.

15. With regard to claims 75, 80 and 109, while the system disclosed by Eggleston and Hall shows substantial features of the claimed invention (discussed above), it fails to disclose that the data items are repackaged using MIME.

The Examiner takes Official Notice that MIME was an old and well known standard for formatting email messages at the time the invention was made. Formatting messages using MIME would have merely been a predictable variation of the formatting used by Eggleston and Hall, since it was a widely used formatting standard for email messages.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use MIME to repackage the data items.

16. Claims 76 and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023) further in view of Halim et al. (US 6,304,881).

17. With regard to claim 76 and 81, while the system disclosed by Eggleston and Hall shows substantial features of the claimed invention (discussed above), it fails to disclose that the data items are repackaged using IMAP.

Halim discloses a similar system for forwarding email messages to a remote device. Halim teaches the user of IMAP for retrieving email messages from an email server (col. 1, ll. 59-63). This would have been an advantageous addition to the system disclosed by Eggleston and Hall since it would have allowed IMAP users to have their email redirected to a wireless device.



Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use permit IMAP users to redirect email messages to a wireless device.

### ***Conclusion***

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **AARON STRANGE** whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

Art Unit: 2448

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/  
Primary Examiner, Art Unit 2448